REMARKS

The present application was filed on January 12, 2001, with claims 1-32. Claims 5, 7, 8, 10, 11, 22-26 and 31 have been canceled. Claims 1-4, 6, 9, 12-21, 27-30 and 32 remain pending. Claims 1, 15, 21, 27-29 and 32 are the pending independent claims.

Claims 1, 3, 4, 6, 9, 12, 15-20, 27-30 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over an article by Thorpe et al. entitled "The All-Digital Camcorder - The Arrival of Electronic Cinematography" (hereinafter "Thorpe") in view of U.S. Patent No. 5,691,772 to Suzuki (hereinafter "Suzuki").

Claims 2 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Thorpe in view of Suzuki and U.S. Patent No. 5,008,739 to D'Luna et al. (hereinafter "D'Luna").

Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Thorpe in view of Suzuki and U.S. Patent No. 6,201,530 (hereinafter "Thadani").

Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Thorpe in view of D'Luna.

In this response, Applicant traverses the §103(a) rejections. Applicant respectfully requests reconsideration of the present application in view of the remarks below.

With regard to the §103(a) rejection of claims 1, 3, 4, 6, 9, 12, 15-20, 27-30 and 32 over Thorpe and Suzuki, Applicant initially notes that a proper *prima facie* case of obviousness requires that the collective teachings of the proposed combination of references must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicant submits that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejection of 1, 3, 4, 6, 9, 12, 15-20 and 27-32 over Thorpe and Suzuki, in that these references collectively fail to teach or

suggest all the claim limitations, and in that no cogent motivation has been identified for combining or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a white balance picture correction process implemented in a digital camera having a processor, a memory and a user interface. The process includes the step of determining a white balance digital camera processing setting for a picture taking venue at a visit to the venue, saving the setting for the venue, and correcting pictures taken at a subsequent visit to the venue with the saved setting. In addition, the determining step further comprises capturing an image utilizing the digital camera and processing the captured image in the processor of the digital camera to determine the white balance setting. Also, the saving step further comprises storing the white balance setting in the memory of the digital camera in a file having an identifier which allows a user of the digital camera to correlate the identifier with the venue. The claim further specifies that the memory is configurable to store the determined white balance setting and at least one additional white balance setting for another picture taking venue, with the determined white balance setting being selectable from the plurality of stored white balance settings, for use in the correcting step, via the user interface of the digital camera.

Thus, in the invention as set forth in claim 1, white balance settings for respective picture taking venues are stored in the memory, using file identifiers which facilitate selection of a particular one of the stored white balance settings upon a return visit to the corresponding venue. One advantage of this approach is that white balance settings do not have to be recomputed each time a photographer visits a given venue. See the specification at, for example, page 5, lines 15-29.

The Examiner argues that the proposed combination of Thorpe and Suzuki meets each and every limitation of claim 1. Applicant respectfully disagrees.

The Thorpe reference at pages 22-23 and in FIG. 16b teaches that a given camera must utilize different plug-in set-up cards in order to support different "image looks." Thus, the Thorpe arrangement appears to expressly require that the photographer carry a separate plug-in card for each venue. This not only fails to meet the claim limitations, as the Examiner has acknowledged, but is a direct teaching away from the invention of claim 1. As noted above, claim 1 calls for storage of multiple

white balance settings for different venues in respective files of a memory, such that a given one of the stored settings can be easily retrieved from the memory using a file identifier.

The Examiner argues that the missing teachings required to meet the claim 1 limitations are found in Suzuki, and more particularly in the teachings at column 4, lines 57-65, of Suzuki. However, the control tables 108 described in that section do not comprise white balance settings for particular picture taking venues, as required by claim 1. Instead, these control tables 108 contain information which is used to provide white balance correction based on generic, non-venue-specific factors such as the "kind of light source used to illuminate the subject." See Suzuki at, for example, column 5, lines 9-30, and column 7, lines 31-40.

Also, Applicant notes that Suzuki does not appear to pre-store a white balance setting for any particular picture taking venue. To the contrary, Suzuki teaches that the white balance setting used to provide white balance correction for pictures taken at a given venue is recomputed upon each visit to the venue, based on the state of the white balance adjustment switch 120, the contents of the control tables 108, and actual color measurements from color measurement unit 130. See Suzuki at, for example, column 4, line 34, to column 5, line 8. This is made further apparent from, for example, FIG. 2 of Suzuki, and the corresponding text from column 3, line 62, to column 4, line 4:

> Referring now to FIG. 2, therein depicted is a blocked [sic] diagram of the general structure of the preferred embodiment of the present invention. In particular, a white balance adjustment unit 503 is shown to receive inputs from an imaging unit 501, an adjustment mode selection unit 502, and a color measurement unit 504. Based on the inputs from the aforementioned imaging unit 501, the adjustment mode selection unit 502, and color measurement unit 504, the white balance adjustment unit 503 is able to perform accurate and efficient white balance adjustment.

Thus, it is clear that in Suzuki there is no storage of white balance settings for particular venues as set forth in claim 1. In fact, since Suzuki teaches storage of control tables 108 which contain only information that is based on generic, non-venue-specific factors, that reference actively teaches away from the limitations of claim 1.

The Examiner further relies on the teachings in FIG. 4 of Suzuki which refer to gain read-out or gain determination for Fine Weather, Cloudy, Tungsten Lamp and Fluorescent Lamp. The Examiner apparently argues that these teachings somehow suggest stored white balance settings for respective picture taking venues as recited in claim 1. However, Suzuki makes clear that a particular one of these gain read-out or gain determination elements is selected using switches 122-125 which are "for the selection of the light source in a manual white balance adjustment mode." See Suzuki at column 5, lines 15-23, and column 6, lines 8-32. As indicated previously, these are not white balance settings for respective venues, but are instead generic, non-venue-specific factors that are used to recompute white balance settings upon each visit to a given picture taking venue or venues. This is apparent from, for example, column 2, line 62, to column 3, line 11, of Suzuki, which provides as follows with emphasis supplied:

> These and other objects are achieved by the present invention in that a white balance adjustment device adapted for use in fluorescent lighting contexts is defined. The white balance adjustment device includes an imaging unit for forming an image of a subject and for outputting that image. Moreover, the white balance adjustment device includes an adjustment mode selection unit for selecting a white balance adjustment mode according to the kind of light source used to illuminate the subject. Further, the device has a measurement unit for measuring color aspects of the light source used to illuminate the subject and for outputting a color value corresponding to the color aspects. Finally, the device includes a white balance adjustment unit for adjusting the white balance of the output of the imaging unit in accordance with the adjustment mode selected by the adjustment mode selection unit and in accordance with the color value measured by the measurement unit.

It is clear from the foregoing that the output of the adjustment mode selection unit in Suzuki does not provide any ability to select a particular white balance setting previously determined for a particular venue. Instead, it simply provides one input to a white balance setting computation process that also utilizes a color value that must be measured upon each visit to a given venue. Thus, Suzuki teaches away from the claimed invention, and suffers from precisely the same problems that Applicant identified at page 1, line 19, to page 2, line 6, of the specification. The invention as set forth in claim 1 advantageously overcomes these problems of Suzuki and the other cited prior art.

It should be noted that the FIG. 4 arrangements in Suzuki that are relied upon by the Examiner are a type of "manual setting for different 'average' illuminants, such as daylight or tungsten," that Applicant described in the Background section of the specification at page 1, lines 20-21. Again, such manual settings do not constitute a white balance setting for a particular picture taking venue as determined at a visit to the venue.

Accordingly, the collective teachings of Thorpe and Suzuki fail to meet the limitations of independent claim 1.

Applicant further submits that the Examiner has not identified objective evidence of motivation to combine Thorpe and Suzuki or to modify their teachings to reach the limitations of claim 1.

As to motivation to combine Thorpe and Suzuki, the Examiner at page 4, first paragraph, of the Office Action argues that the combination would be obvious "in order to provide the user with only one memory card with several venues on it." Applicant respectfully submits that the proffered motivation is deficient at least in part because it is conclusory. That is, the statement apparently argues that the combination of Thorpe and Suzuki would be obvious because it would provide a feature of one embodiment of the claimed invention. Such a statement appears to indicate that the Examiner is using the teachings of the present application to demonstrate motivation for the proposed combination, which is clearly improper. As noted above, Suzuki does not teach or suggest the claimed storage of venue-specific white balance settings, and

in fact teaches away from such an arrangement by teaching the use of generic, non-venue-specific factors similar to the "manual settings for different 'average' illuminants" recited by Applicant at page 1, lines 20-21, of the specification. Thorpe also teaches away from the claimed invention, as indicated previously herein.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination "must be based on objective evidence of record" and that "this precedent has been reinforced in myriad decisions, and cannot be dispensed with." In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that "conclusory statements" by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved "on subjective belief and unknown authority." Id. at 1343-1344. There has been no showing in the §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Thorpe and Suzuki to produce the particular limitations in question. Instead, the proposed combination appears to be based on a piecemeal reconstruction of the claimed invention, with the benefit of hindsight, rather than on any objective evidence of motivation. Accordingly, the §103(a) rejection of independent claim 1 is believed to be improper and should be withdrawn.

Independent claims 15, 27 and 28 are believed allowable for reasons similar to those identified above with regard to claim 1.

Independent claims 29 and 32 were previously amended to incorporate a limitation relating to a user interface which allows both naming of and selecting from white balance correction values. Applicant submits that there is no teaching or suggestion in the proposed combination of Thorpe and Suzuki regarding a user interface which allows both naming of and selecting from white balance correction values, as recited.

The dependent claims are believed allowable for at least the reasons identified above with regard to their respective independent claims.

With regard to the §103(a) rejection of dependent claims 2 and 14 over Thorpe and Suzuki in view of D'Luna, Applicant submits that the D'Luna reference fails to supplement the fundamental deficiencies of Thorpe and Suzuki as applied to

independent claim 1. Accordingly, claims 2 and 14 are believed allowable over the proposed combination of Thorpe, Suzuki and D'Luna.

With regard to the §103(a) rejection of dependent claim 13 over Thorpe and Suzuki in view of Thadani, Applicant submits that the Thadani reference fails to supplement the fundamental deficiencies of Thorpe and Suzuki as applied to independent claim 1. Accordingly, claim 13 is believed allowable over the proposed combination of Thorpe, Suzuki and Thadani.

With regard to the §103(a) rejection of independent claim 21 over Thorpe in view of D'Luna, Applicant notes that the claim calls for assigning file name identifiers to different image processing settings, and saving the settings in a removable non-volatile memory. As described above in the context of claim 1, Thorpe fails to teach or suggest an arrangement of this type, and in fact teaches away from it. The D'Luna reference fails to supplement the fundamental deficiencies of Thorpe in this regard. Accordingly, claim 21 is believed allowable over the proposed combination of Thorpe and D'Luna.

It is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225. ***A duplicate copy of this communication is enclosed.***

Respectfully submitted,

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